

## REMARKS

Claims 1-7 are pending in the application.

The examiner's rejections are overcome or they are traversed as set forth below.

### I. TRAVERSE OF THE ANTICIPATION REJECTION OF CLAIMS 1-4 AND 6-7

The examiner finally rejected claims 1-2 and 4-7 for anticipation in view of Tischer *et al.* (USP 6,328,031). The examiner dismissed the applicants argument that Tischer *et al.* does not include the claimed first sub-assembly "seal" by taking the position that because of the manner in which the claims are drafted, all that needs to be shown is that Tischer *et al.* includes a structure that is capable of sealing around the periphery of user's face and by taking the further position that support frame 148 "inherently" creates a seal against the periphery of the user's face when the user has a large head.

The examiner's positions are without merit for several reasons. First of all, the examiner's inherency argument is contrary to law. In addition, the Tischer *et al.* support frame 148 never touches the user's face so it is impossible for support frame 148 to seal around the user's face. Finally, the examiner's rejection is based upon an erroneous construction of the term "seal".

#### A. The Examiner's Inherency Position Is Legally Flawed

It is the examiner's position that the Tischer *et al.* support frame 148 inherently seals around a user's face when a user with a large head wears the hood assembly. The examiner's inherency argument is legally flawed because inherency cannot be established by probabilities. For this reason, claims 1-2 and 4-7 are novel over Tischer et al.

In order for a prior art reference to have an inherent feature or step, a structure or step in the prior art must necessarily function in accordance with the anticipated claim feature. *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986). Put another way, accidental results that are not intended or appreciated do not constitute anticipation. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923). Indeed the Federal Circuit has confirmed that inherency may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient to establish inherency. *Continental Can Co. v. Monsanto Co.*, 948 F.2d. 1264, 1269, 20 USPQ 2<sup>nd</sup> 1746, 1749 (Fed. Cir. 1991).

It is the examiner's position that the support member would inherently create a seal around the user's face, especially if the hood is worn by a user with a large heard. However, the examiner's argument is improperly based upon possibility and probability. The examiner has not shown – as he must – that support frame will form a seal around the user's face when the device is worn. This is because the examiner's inherency position is not based upon a necessary consequence of wearing the device disclosed in Tischer *et al.* Tischer *et al.* never discloses that support frame 148 is a seal of any sort. Moreover, there is absolutely no description in Tischer *et al.* that the support frame 148 touches the user's face. Thus, the only possible support that the examiner could point for the inherency position would be the Tischer *et al.* figures. But even the Tischer *et al.* figures fail to provide support for the examiner's inherency argument. None of the figures show support frame 148 contacting the user's face.

The alleged formation of a seal around a user's face is not the natural consequence of a user wearing the respirator of Tischer *et al.* The examiner's inherency position, therefore, is based upon probability and possibility which cannot as a matter of law support an inherency position. For at least this reason, claims 1-2 and 4-7 are novel over Tischer *et al.*

#### **B. Support Frame 148 Never Contacts The Wearer's Face**

The examiner continues to argue that support frame 148 is capable of forming a seal around the user's face. As the applicant previously stated, the purpose of the support frame is to provide support for the face mask while requiring a minimum number of fasteners. Figures 15 and 16 are cross sectional views of the firefighting hood and face mask assembly. In Figures 15 and 16, support frame 148 and the user's face and head are separated by several structures. Therefore it is physically impossible for support frame 148 to contact a user's face when worn. Therefore it is impossible to form a seal between the user's head and support frame 148 of Tischer *et al.* Claims 1-2 and 4-7 are novel for this reason as well.

#### **C. The Examiner Misconstrues The Term "Seal" In Claim 1**

The examiner's decision to give the term "adapted to seal against the periphery of the user's face" little patentable weight is also believed to be improper. Claim 1 recites a first sub-assembly including seal. The specification discloses that the first sub-assembly seal is a face seal. Therefore, the term "seal" used to identify a feature of the first sub-assembly refers to a face seal – not a structure that is "capable of forming" a seal as the examiner has interpreted the

entire phrase.

The examiner's rejection ignores the "seal" feature claim limitation and focuses instead on the "adapted to seal . ." language of claim 1. In order to properly evaluate claim 1, the examiner must identify a prior art device that includes a first sub-assembly including a "seal". The examiner has not met this burden and, therefore, has not established a prima facie case of anticipation. Claims 1-2 and 4-7 are, therefore, novel over Tischer *et al.* for this reason as well.

## **II. TRAVERSE OF THE ANDREWS *ET AL.* ANTICIPATION REJECTION**

The examiner rejected claims 1-5 and 7 for being anticipated by Andrews et al. (USP 2,935,985). As with Tischer *et al.*, the examiner rebuts the Applicant's position that the reference does not disclose a seal around the user's face by taking the position that such a seal is inherent from the Andrews et al. disclosure when the helmet is worn by a "user with a bigger head compared to the hood"

As with Tischer *et al.* and as set forth in Section I(A) above, the examiner's inherency position is improperly based upon possibility and probability. The examiner has not shown – as he must – that feature 5c will form a seal around the user's face when the helmet is worn. This is because the examiner's inherency position – that feature 5c of Andrews et al. is a face seal - is not premised on the natural consequence of wearing the Andrews et al. hood. Instead, the examiner's position is based upon possibility and moreover on possibilities that are not even suggested by the reference. Moreover, Andrews et al. provides absolutely no disclosure or suggestion that feature 5c ever contacts the face of the hood wearer under any circumstance. Thus, the alleged formation of a seal around a face of a user with a large head is not the natural consequence of a user wearing the Andrews et al. helmet and for at least this reason, claims 1-5 and 7 are novel over Andrews et al.

Claims 1-5 and 7 are also novel over Andrews et al. because the examiner has construed the term "seal" far too narrowly as set forth in Section I(B) above. Indeed, there is no disclosure or suggestion in Andrews et al. that feature 5c would ever contact the face even if the user had a large head. The examiner cited Andrews Figure 4 as showing the alleged seal. However, it is clear from looking at Figure 4 that the upper and lower peripheral margins of feature 5c are spaced in front of the forehead and chin regions of the normal user's face and that the presence of

the foam pad 41 inside the helmet would maintain this spacing even in relation to a wearer with a large head. Therefore, the examiner's position that a user with a large head would have a face that would abut feature 5c around its periphery is not merely unsupported by but actually contrary to the teaching of Andrews et al. and claims 1-5 and 7 are novel for this reason as well.

### **III. TRAVERSE OF THE OBVIOUSNESS REJECTION OF CLAIM 6**

The examiner rejected claim 6 for being obvious over Andrews et al. in view of Bonhomme et al. (USP 6,520,177)

The examiner's rejection of claim 6 for obviousness must be withdrawn because Andrews et al. does not disclose an assembly that includes a seal against the periphery of the user's face when worn as set forth in Section II above.

### **CONCLUSION**

Claims 1-7 are pending in the application and are believed to be patentable for at least the reasons identified above. Favorable consideration and allowance of all pending application claims is courteously solicited.

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